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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/804,335	03/19/2004	Leslie LiDonnici	1363-3	7024

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EXAMINER

COMSTOCK, DAVID C

ART UNIT

PAPER NUMBER

3732

DATE MAILED: 02/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/804,335	<b>Applicant(s)</b> LIDONNICI, LESLIE	
	<b>Examiner</b> David Comstock	<b>Art Unit</b> 3732	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-28 and 30 is/are rejected.
- 7) ☒ Claim(s) 5, 29 and 31 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>06/04</u> . | 6) <input type="checkbox"/> Other: ____.  |

## **DETAILED ACTION**

### ***Claim Objections***

Claims 22-26 are objected to because of the following informalities: Claim 22 depends from claim 20 (i.e. "the method according to claim 20"); however, claim 20 is not directed to a method. For examination purposes and as best understood, claim 22 will be treated as depending from method claim 21. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 10-12, 21-23 and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by Symbas et al. (4,627,421).

Symbas et al. disclose a metal sternal retractor comprising end walls 28A, 28B, each having an integrally formed upper and lower wall 41 extending orthogonally from, and interconnected by, the end wall. The device has a flat C-shaped transverse cross-sectional profile. The walls are placed between exposed sternal halves to exert a force against and retract the same. (See figures 1 and 3 and column 2, line 50 - column 4, line 8.)

Claims 1-4 and 10-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Colon (D440,268).

Colon discloses a molded plastic device comprising an end wall interconnecting an upper wall and a lower wall extending orthogonally from the end wall. The device includes curved or arcuate end walls. The device has a U or C-shaped cross-section. (See Figure 1.)

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 13-18, 24-26 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Symbas et al. (4,627,421).

Symbas et al. disclose the claimed invention except for explicitly disclosing a radius of curvature of about 8.625 inches, an upper wall thickness of about 0.1875 inches, a lower wall thickness of about 0.0625 inches, or walls of equal thickness. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the retractor of Symbas et al. with a radius of curvature of about 8.625 inches, an upper wall thickness of about 0.1875 inches, a lower wall thickness of about 0.0625 inches, or walls of equal thickness, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233. It

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would have been further obvious to form the device of plastic, polycarbonate, stainless steel, or titanium, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Claims 13-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Colon (D440,268).

Colon discloses the claimed invention except for explicitly disclosing a radius of curvature of about 8.625 inches, an upper wall thickness of about 0.1875 inches, a lower wall thickness of about 0.0625 inches, walls of equal thickness, or a space between the upper and lower walls of about 0.75 inches. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the device of Colon with a radius of curvature of about 8.625 inches, an upper wall thickness of about 0.1875 inches, a lower wall thickness of about 0.0625 inches, walls of equal thickness, or a space between the upper and lower walls of about 0.75 inches, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233. It would have been further obvious to form the device of plastic, polycarbonate, stainless steel, or titanium, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Claims 6-9 and 30 are rejected under 35 U.S.C. 102(b) as being anticipated by Symbas et al. (4,627,421) in view of Jacques (2,238,563).

Symbas et al. disclose the claimed invention except for the spike on the end wall. Jacques discloses a similar device having a spike 21 on an end wall 20 in order to retain the device in place and free the hands of the operator (see Jacques, Fig. 7 and col. 3, lines 37-44). It would have been obvious to a person of ordinary skill in the art to provide the retractor of Symbas et al. with a spike on the end wall, in view of Jacques, in order to retain the device in place and free the hands of the operator. It would have been further obvious to make an element of the device removable, since it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. *Nerwin v. Erlichman*, 168 USPQ 177, 179.

#### ***Allowable Subject Matter***

Claims 5, 29 and 31 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to David C. Comstock whose telephone number is (703) 308-8514.



D. Comstock  
06 February 2005



**EDUARDO C. ROBERT**  
**PRIMARY EXAMINER**